

Docket No. P03927

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appellant : Thomas A. Todd et. al.
Serial No. : 10/665,955
Technology Center : 1700
Art Unit : 1714
Filed : September 17, 2003
Title : "Fuel Additive Systems"
Examiner : Cephia D. Toomer
Docket No. : P03927

Mail Stop Appeal Brief- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT'S REPLY BRIEF

Dear Sir,

In response to the Examiner's Answer mailed 8/01/2008, appellant submits the following
Reply Brief.

Appellant maintains all of appellant's previous arguments and includes all such arguments
herein by this reference.

CERTIFICATE OF TRANSMISSION

I hereby certify that, on the date shown below, this correspondence is being transmitted to the U.S. Patent and Trademark Office by EFS-Web.

Date: September 30, 2008

/Glenn W. Stoneman/

Signature

Glenn Stoneman

(type or print name of person certifying)

ISSUE 1: DOES THE USAGE OF THE TERM “COMPREHENSIVE FUEL ADDITIVE” IN CLAIMS 1, 7, 19 AND 55 RENDER THESE CLAIMS INDEFINITE?

With regard to Issue 1, appellant submits that there is no requirement that a combination of components may not be recited in a claim limitation. Further, the Examiner has not provided any rule or cited any court decisions that such a requirement exists. On page 13 of the Examiner’s answer, the Examiner essentially admits that appellant’s teachings include a proper defining of those words. It is respectfully submitted that the term “comprehensive fuel additive” is used properly to limit the scope of the claims such that a comprehensive fuel additive may be provided to transportation fuels.

ISSUE 2: DOES THE USAGE OF TRADEMARKED FUEL ADDITIVES IN CLAIMS 15, 31, 36-38, 40-43, AND 46-53 RENDER THESE CLAIMS INDEFINITE?

The MPEP is very specific that “the presence of a trademark or trade name in a claim is not, *per se*, improper under 35 U.S.C. 112, second paragraph”. MPEP §2173.05. Appellant submits that the Examiner, in not following this MPEP rule, has not properly given due attention to the evidence submitted in this matter (the Declaration of Edward R. Eaton). Appellant must use trademarks as chemical descriptors because these formulations are typically trade secrets that cannot be described in any other way; and performance of the claimed invention is fully enabled for anyone since, in this art, these formulations are purchasable and never change.

ISSUE 3: UNDER 35 USC §103(a), DOES CUNNINGHAM’S “ENHANCED FUEL ADDITIVE CONCENTRATE” RENDER OBVIOUS THE SUBJECT MATTER OF CLAIMS 1-14, 19-30, 35, 37-42, 44, 45, 47-52, AND 54-60?

Appellant notes that the 35 USC §103(a) rejection is limited to a single piece of art (Cunningham) viewed in light of appellant’s teaching specification. Appellant respectfully submits

that a 35 USC §103(a) rejection based on a single piece of art should certainly “smell” of forbidden hindsight.

In the Examiner’s answer, the Examiner admits that Cunningham is directed to improving the shelf-life of an additive package (rather than being directed to the problem appellant discovered and solved, namely, briefly, the lowering of emissions in low quality fuels where such solution needs to be able to be uniformly accomplished by users in a straightforward way).

The Examiner states, “It appears that all Appellant has done is taken conventional fuel additives and prepared a concentrate of those additives”. Appellant not only respectfully disagrees, but respectfully points out the subtle universal disparagement tone of the statement form “...all that was done was...”. Appellant must assume that the Examiner intended to argue that Appellant solved no commercially significant problem at *all*.

To the contrary of the Examiner’s above statement, appellant’s specification states at least one commercially significant problem solved by appellant’s claimed invention. For example, appellant’s specification states the following:

In the course of their worldwide travels, the inventors experienced the increasing pollution that was becoming a concern in developing countries as their economies grew faster than local industry technologies’ ability to prevent or clean up the emissions. Discussions with many government officials demonstrated an unmet need for a fuel chemistry that would contribute to national goals that included reducing emissions, improving fuel efficiencies, and generally extending the life of vehicles and other equipment, all desirable objectives in developing economies (appellant’s Specification at page 54, lines 28-30 to page 55, lines 1-4).

Appellant’s claimed system has significant commercial importance, particularly in respect to *assisting the use of low quality fuels with less significant pollution of the Earth*, as pointed out in

appellant's teaching specification. Further, detailed enabling listings of appellant's claimed invention are provided in appellant's specification as part of its contribution to the useful arts per the U.S. Constitution and Title 35 of the U.S. Code.

With respect to the Examiner's argument relating to a "result-effective variable", it is noted that the Examiner has essentially admitted that Cunningham is directed to improving the shelf-life of the additive package. The Examiner argues that "the claimed components are result-effective variables" citing *In re Boesch* in the Final rejection. *In re Boesch* dealt with the question of whether or not optimizing a "result effective variable" in a known process is ordinarily within the skill of the art. The present case does not involve a result-effective variable since there is *no* recognition in the prior art of *any* fuel additive being used in a comprehensive-single-addition transportation fuel additive. The Cunningham reference merely provides a recipe for enhancing the shelf-life of one particular type of detergent additive.

The Appellants have demonstrated that the present invention as claimed is clearly presented in proper form and distinguishable over the prior art of record. Therefore, the Appellants respectfully request the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

If there are any fees necessitated by the foregoing communication, please charge such fees to, or credit any overpayment, to our Deposit Account No. 50-1887 referencing docket #P03927.

Respectfully submitted,

Date: September 30, 2008

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